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| 09 726,796 | 11 30 2000 | J. Eric Launtzen | WEAT 0072 | 5691 |

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EXAMINER

POPOVIC'S, ROBERT J

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1723

4

DATE MAILED: 03 07 2002

Please find below and/or attached an Office communication concerning this application or proceeding.

T-D-4

Office Action Summary

| | |
|-------------------------------|----------------------------------|
| Application No. 09/726,796 | Applicant(s) Lauritzen et al. |
| Examiner Popovics | Group Art Unit 1723 |

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE Three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 4/23/01
- ☐ This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-31 is/are pending in the application.
- Of the above claim(s) 12-27 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-11 And 28-31 is/are rejected.
- Claim(s) _____ is/are objected to.
- Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- The drawing(s) filed on _____ is/are objected to by the Examiner.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) _____

received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- Information Disclosure Statement(s), PTO-1449, Paper No(s). _____ Interview Summary, PTO-413
- ☒ Notice of Reference(s) Cited, PTO-892 Notice of Informal Patent Application, PTO-152
- Notice of Draftsperson's Patent Drawing Review, PTO-948 Other _____

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-11 and 28-31, drawn to a COATED WELLSCREEN, classified in class 210, subclass 506.
 - II. Claims 12-27, drawn to a METHOD OF COATING A WELLBORE COMPONENT, classified in class 427, subclass 384.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions Group II and Group I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process, such as spraying, etc. Moreover, the process of Group II can be used to make a materially different product other than that of Group I, such as any wellbore component other than a wellscreen, as is required by the product of Group I.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

5. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II and vice versa, restriction for examination purposes as indicated is proper.

6. During a telephone conversation between Mr. William Patterson and Examiner Michael E. Barr, on December 10, 2001 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-11 and 28-31. Affirmation of this election must be made by applicant in replying to this Office action. Claims 12-27 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claim 1 is rejected under 35 U.S.C. 102(a)(b) as being anticipated by AAPA (Applicants' Admitted Prior Art).

At page 3, lines 16-22, Applicants teach/admit the following:

In response to the erosion and corrosion problems, protective coatings have been applied to the wellscreen. However, the conventional techniques typically require the coating to be sprayed onto wellscreen, which can waste the coating materials and may not adequately cover the entire screen. In addition, the spraying technique does not apply the coating evenly on the wellscreen leaving parts of the wellscreen at least partially exposed to erosion and corrosion. Further, the conventional techniques coat only the screen portion of the wellscreen, leaving the other components, like the interior base pipe, susceptible to erosion.

10. Claims 1,5,8-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Muecke et al. (3,880,233).

See coating layers 27-28.

11. Claims 1-3,8-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Sato et al. (3,871,411).

Nickel plating is disclosed.

12. Claims 1,5-9,28 and 30-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Arterbury et al. (5,339,895).

See perforated mandrel 38.

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Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

15. Claims 1-4,8-11,28-29 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA (Applicants' Admitted Prior Art) in view of Richardson (3,685,582).

At page 5, numbered line 7, Applicants teach admit that the "wellscreen is a typical wellscreen known to those skilled in the art such as wellscreen 126." Applicants urge that *coating* of this known wellscreen constitutes the invention - as recited in their claims. Richardson discloses "*plating metal on materials composing or contained in a permeable structure in which the plating solution can be contained or through which it can be flowed, e.g., a heated autoclave, a hot tank or boiler tube, or the like,*" and "*It is useful for depositing metal in order*

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to provide a protective coating on a conduit." See column 2, lines 30-50. In view of this disclosure, it would have been obvious to one of ordinary skill in the art to employ the nickel and phosphorous containing plating disclosed by Richardson on the well known wellscreen structure in order to provide a protective coating thereon. The limitations drawn to the various composition percentages, *as understood*, are submitted to be inherent in Richardson, or alternatively, to represent routine optimizations which would have been obvious to one of ordinary skill in the art.

Claim Rejections - 35 USC § 112

16. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

17. Claims 1-11 and 28-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to the term "*wellscreen*," it is unclear what minimal components make up a "*wellscreen*," or how a "*wellscreen*" differs from any other type of screen.

It is unclear how Applicants intend claims 8-9 to further limit the *structure* of the apparatus claims from which they depend. For the purposes of the art rejections above, claims 8-9 were seen to add nothing in the way of limitations.

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It is unclear what Applicants intend the stated *percentages* to represent in claims 10-11 and 29.

In claim 7, it is unclear what Applicants intend by the recitation "*cermet*."

Conclusion

18. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Examiner Robert Popovics whose telephone number is (703) 308-0684, and who can normally be reached at this number from 9:30 A.M. through 6:00 P.M. (EST) M-F.

A handwritten signature in black ink, appearing to read 'R. Popovics', with a long horizontal flourish extending to the right.

Robert James Popovics
Primary Examiner
Art Unit 1723

rjp
March 6, 2002